

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

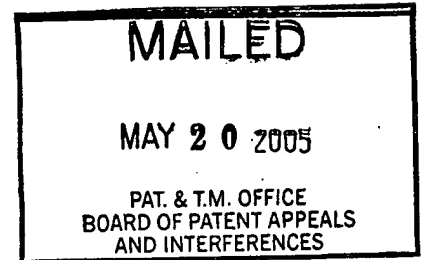
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte R. DANIEL MCGRATH, BENNETT H. ROCKNEY,
VINCENT S. CLARK and SURINDERJIT S. DHALIWAL

Appeal No. 2005-0429
Application No. 09/872,209

ON BRIEF



Before HAIRSTON, LEVY, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9.

Invention

Appellants' invention relates to an integrated imager system that uses on-chip logic to generate complex timing on-chip. The imager system has an interface for receiving data, address and control signals, including a mode signal for setting the system either to operate using the on-chip timing system or to bypass the on-chip timing system and operate using an external timing system. The imager of the present invention provides high quality images using an easy interface and simple operation in order to reduce time and cost. The invention

also provides the user the option to take control of every aspect of scan timing externally in an FPGA if the user requires the modes of operation to be extended for advanced imaging. Appellants' specification page 3, lines 12-24.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An improved CMOS integrated imager system having an array of pixel areas with at least one control area, wherein said pixel areas include a plurality of light collecting elements which each receive light and store electronic information in an amount indicative of an amount of light received during an integration period, with the control area having an internal timing element, wherein the improvement comprises:

a user interface for receiving a plurality of data, address, and control signals, said interface configured to receive from a user a mode signal for setting the system in one of a first operating mode or a second operating mode characterized in that the first operating mode uses the internal timing element to control timing operation of the system and the second operating mode bypasses the internal timing element to control timing operation of the system.

References

The references relied on by the Examiner are as follows:

Noble et al. (Noble)	5,760,636	Jun. 2, 1998
Shinohara	EP 0942592	Sep. 15, 1999

Rejections At Issue

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Shinohara and Noble.

Claims 7-9 stand rejected under 35 U.S.C. § 103 as being obvious over Shinohara.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-9 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in two groupings:

Claims 1-6 as Group I; and

Claims 7-9, as Group II.

See page 5 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 6-15 of the brief and pages 2-4 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7)

¹ Appellants filed an appeal brief on October 14, 2003. Appellants filed a reply brief on March 5, 2004. The Examiner mailed an Examiner's Answer on December 30, 2003.

(July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192

(c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the two groups noted above, and we will treat:

Claim 1 as a representative claim of Group I; and

Claim 7 as a representative claim of Group II.

I. ***Whether the Rejection of Claims 1-6 Under 35 U.S.C. § 103 is proper?***

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1-6. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 6 of the brief, "[t]he timing transfer is not a user selected mode." We have reviewed claim 1 and find no such limitation in the claim. There is no structure in claim 1

that performs the function of a user selecting a mode. Rather, the structure recited is “an interface configured to receive . . . a mode signal” with the mode signal “setting the system in one of a first operating mode or a second operating mode.” We find Appellants’ argument unpersuasive.

We note that both Appellants and the Examiner have given significant weight to the word “user” in claim 1. We find this weight to be unjustified as there are no structural elements in claim 1 that are not found in Shinohara. Appellants are arguing that the structure of the claimed interface differs from the structure in Shinohara merely because a “user” is the source of the “mode signal.” We find the opposite. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus”, if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). As pointed out by the Examiner in the rejection of claim 1 (answer at pages 3-4), Shinohara teaches all of the structure of the interface except that “the mode signal [is] from a user.” We agree and as noted above, we find that the source of the mode signal is of no significance as to the structure of the interface.

Appellants also argue at page 7 of the brief that “[t]he claimed ‘first mode’ is not simply a preliminary operation . . . , but rather is a complete imaging operation.” We find this argument unpersuasive as no such limitations are found in claim 1. Rather, the claim only requires that the “first operating mode uses

the internal timing element to control timing operation of the system.” We find no claim limitations directed to the type of operation to be performed as argued by Appellants.

In view of the above discussion, it is our view, that since Shinohara teaches all the structure of claim 1, Noble is not necessary for a proper rejection under 35 U.S.C. § 103 of representative claim 1. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” **Jones V. Hardy**, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). **See also In re Francalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).² Accordingly, the Examiner’s obviousness rejection of representative claim 1 is sustained based on Shinohara alone.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 7-9 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 7-9. Accordingly, we affirm.

² The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. **In re Bush**, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); **In re Boyer**, 363 F.2d 455, 458 n.2 150 USPQ 441, 444 n.2 (CCPA 1966).

With respect to independent claim 7, Appellants argue at page 12 of the brief that it would not have been obvious to establish “a user interface to allow selection of the onboard timing means or outboard logic circuit.” We find Appellants’ argument unpersuasive.

As with claim 1 discussed above, we note that both Appellants and the Examiner have given significant weight to the word “user” in claim 7. Again, we find this weight to be unjustified as there are no structural elements in claim 7 that are not found in Shinohara. Shinohara teaches an interface (10) allowing selection between the two timing means (Column 3, lines 19-23). As with claim 1, Appellants are arguing that the structure of the claimed interface differs from the structure in Shinohara merely because a “user” is the source of the “mode signal.” Again, we find the opposite.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1-9.

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

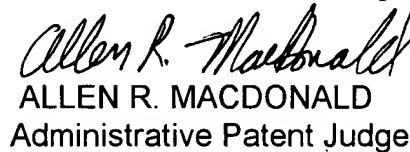
AFFIRMED



KENNETH W. HAIRSTON
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge



ALLEN R. MACDONALD
Administrative Patent Judge

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